

REMARKS

I. Introduction

Claims 1-14 and 16-23 are pending in the application. By this amendment claims 1-14 and 16-19 are amended to more clearly recite the features of the invention. Claims 20-23 are added to more particularly recite the amount of syndiotactic polypropylene in the composition. Paragraph 0019 of the specification is amended to correct a typographical error. Reconsideration of the application in view of the present amendment is respectfully requested.

II. Claim Rejection under 35 U.S.C. § 112, second paragraph

In numbered paragraph 1 on page 2 of the Office Action dated August 22, 2005, claim 1 is rejected as being indefinite because of the recitations “on the basis of” and “in a viscosity promoter amount”. By this Amendment, claim 1 is amended to remove the phrase “on the basis of” and further to recite the syndiotactic polypropylene being “present in an amount sufficient to function as a viscosity promoter”. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

III. Claim Rejections under 35 U.S.C. § 102(b)

In numbered paragraphs 6-8 on page 3 of the Office Action, claim 1 is rejected as being clearly anticipated by EP 000618259A2 (“the ‘259 reference”). The Office Action states that “[n]o patentable difference is ascertained” between claim 1 and the ‘259 reference. By this Amendment, claim 1 is amended to recite:

A thermoplastic elastomer composition comprising
an isotactic polypropylene and EPDM blend, the EPDM
being cross-linked; and
syndiotactic polypropylene present *in an amount sufficient
to function as a viscosity promoter*. (emphasis added)

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *see* M.P.E.P § 2131. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d

1913, 1920 (Fed. Cir. 1989).

In this case, the ‘259 reference discloses a thermoplastic elastomer including “essential” components: 10-90 wt.% of polypropylene having a substantially syndiotactic structure, and 90-10 wt.% of a cross-linked ethylene-propylene-nonconjugated copolymer diene rubber and/or a cross-linked ethylene-propylene copolymer rubber (*see e.g.*, page 2, lines 54-57). An organic peroxide is employed as a cross-linking agent (page 3, line 57). The composition is further taught as optionally including isotactic polypropylene (page 5, line 4), a cross-linking aid (e.g., bisaleimides) (page 4, line 25), and a filler (e.g., calcium carbonate) (page 5, lines 10-11). Syndiotactic polypropylene is, thus, a primary component of the composition in the ‘259 reference whereas isotactic polypropylene is taught as being an optional component.

In contrast, claim 1 of the instant application recites “an isotactic polypropylene and EPDM blend, the EPDM being cross-linked; and syndiotactic polypropylene present in an amount sufficient to function as a viscosity promoter”. The ‘259 reference, thus, fails to disclose the identical invention in as complete detail as contained in claim 1 because the syndiotactic polypropylene therein is not “present in an *amount sufficient to function as a viscosity promoter*” (emphasis added).

Reconsideration of amended claim 1 is respectfully requested. Claims 16, 17, 20 and 22 depend from claim 1 and are submitted as being allowable for at least the same reasons.

IV. Claim Rejections under 35 U.S.C. § 103(a)

In numbered paragraphs 2-4 on page 2 of the Office Action, claims 1-19 are rejected as being unpatentable over the ‘259 reference. By this Amendment, claims 1-14 and 16-19 have been amended to more clearly recite the features of the invention. For at least the reasons below, Applicant respectfully submits that claims 1-14 and 16-22 are allowable over the ‘259 reference.

Claims 1-2

Claims 1 and 2, as amended, both recite “syndiotactic polypropylene present in an amount sufficient to function as a viscosity promoter.” Amended claim 2, for example, recites:

A thermoplastic elastomer composition, comprising:
ethylene propylene terpolymer,
isotactic polypropylene,
*syndiotactic polypropylene present in an amount
sufficient to function as a viscosity promoter,*

mineral filler material,
mineral oil, and
cross-linking catalyst. (emphasis added)

As substantially set forth above with regard to claim 1, syndiotactic polypropylene is, thus, provided in claim 2 as a formula admixture to a blend of ethylene propylene terpolymer and isotactic polypropylene. In contrast, syndiotactic polypropylene is a primary and “essential” component (page 4, lines 57-58) of the composition in the ‘259 reference being present in amounts of between 10-90% by weight in the composition. Thus, the ‘259 reference fails to teach or suggest all of the features recited in the claims and the Office Action fails to provide any suggestion or motivation to include the features or modify the ‘259 reference. Reconsideration of claims 1 and 2, as amended, is respectfully requested. Claims 16, 17, 20, and 22 depend from claim 1 and are submitted as being allowable for at least the same reasons. Claims 3-14, 18, 19, 21, and 23 depend from claim 2 and are submitted as being allowable for at least the same reasons.

Claims 6-8

The Office Action also fails to present a *prima facie* case of obviousness with regard to the specific examples recited for each component in claims 6-8. The ‘259 reference does not teach all of the recited limitations and, furthermore, the Office Action fails to provide any suggestion or motivation to modify the reference to include the enumerated components. With regard to claim 6, although the ‘259 reference teaches the optional addition of a “processing oil” or “softener,” it does not set forth why one of ordinary skill in the art would select “a mineral oil selected from the group consisting of a naphthene-based solvent and a paraffin-based solvent”. Similarly, with regard to claim 7, the Office Action points out that the ‘259 reference teaches a “crosslinking aid” but does provide reasoning why one of ordinary skill in the art would include “tin-(II)-chloride or salicylic acid” as recited in amended claim 7. With regard to claim 8, the ‘259 reference fails to teach or suggest including an “alkyl phenol resin selected from the group consisting of octylphenol and nonylphenol”. The Office Action also does not provide reasoning why one of ordinary skill in the art would include this component. Reconsideration is respectfully requested.

New Claims 20-23

New claims 20-23 are added to more particularly recite the relative amount of syndiotactic polypropylene in the composition. Claims 20 and 21 recite that “the syndiotactic polypropylene is present in amounts of between about 2 parts and about 4 parts.” Support is provided, for example, by Table 1. Furthermore, claims 22 and 23 recite “the maximum amount of syndiotactic polypropylene is about 4 parts.” Applicant respectfully submits that this differs from the ‘259 reference which effectively teaches syndiotactic polypropylene being present in amounts of between 10-90% by weight in the composition. The syndiotactic polypropylene in the ‘259 reference is, thus, a primary component whereas the instant invention includes syndiotactic polypropylene as a formula admixture to promote viscosity. In fact, the ‘259 reference teaches away from the amount of syndiotactic polypropylene being less than 10 parts per 100 parts of composition (*see* page 3, lines 10-14 of the ‘259 reference).

V. Conclusion

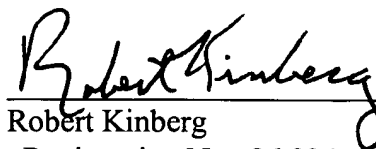
For the foregoing reasons, it is submitted that all of the claims are allowable and that the application is in condition for allowance. An early notice to that effect is respectfully requested. It is not believed that extensions of time or other fees are required beyond those that may otherwise be provided for in documents accompanying this paper. If, however, additional extensions of time are needed to prevent abandonment of this application, such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims or any other fee deficiency), are hereby authorized to be charged, and any overpayments credited to, our Deposit Account No. 22-0261.

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The Examiner is respectfully requested to contact Applicant's undersigned Representative if necessary to place the application in condition for allowance. Prompt reconsideration is respectfully requested.

Respectfully submitted,

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